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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,941	06/17/2005	Harald Wolf	3926.177	1142

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AKERMAN SENTERFITT
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EXAMINER

ADAMS, GREGORY W

ART UNIT	PAPER NUMBER
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3652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/539,941	Applicant(s) WOLF, HARALD	
	Examiner Gregory W. Adams	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/06</u> . | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 & 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Leuthold et al. (US 5,803,446).

With respect to claim 1, Leuthold et al. disclose a method for transporting bodywork panels comprising:

- stacking an associated group of panels 1, 2 on at least one carrier unit 20, 40;
- transporting the group of panels as far as a panel removal station (indicated generally as 30); and
- in each case removing an individual bodywork panel by a panel separation device 31.

With respect to claim 2, Leuthold et al. disclose bodywork panels of a respective group of panels are arranged stacked on edge in the carrier unit at a panel group formation station. Applicant is respectfully reminded that to be entitled to patentable weight in method claims, the structural limitations recited therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 135 USPQ 31 (1961). Here, the structural limitations of a ... do not impact the method as required, thus amounting to the mere claiming of a use of a particular structure. Applicant is claiming a method but the method claim does

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not recite a step, e.g. it doesn't have a "providing" or "using" or some other **-ing** ending word that provides the active step. Thus, its only intended use and given very little patentable weight. See also claims 3-6. For purposes of examination the Examiner assumed an active step was recited. It is also noted that "edge" alone is a relative term. Leuthold's stack 2 could certainly be construed as "edge" the long dimension as it the point where the two short dimensions terminate. (www.dictionary.com)

With respect to claim 3, Leuthold et al. disclose a group of panels in a carrier unit 20, 40 is built up by means of the successive deposition of individual bodywork panels.

With respect to claim 4, Leuthold et al. disclose an individual bodywork panels 1, 2 are deposited in the carrier unit manually or in an automated manner, forming the group of panels. Applicant is respectfully reminded that it was known at the time of the invention that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). And, it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. *In re Venner*, 120 USPQ 192.

With respect to claim 5, Leuthold et al. disclose a group of panels transported from a panel group formation station as far as the panel removal station in a transport direction that extends obliquely upward.

With respect to claim 6, Leuthold et al. disclose a respective group of panels that is transported by means of the transport device during a predefinable cycle time, the

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cycle time depending on the required panel separation time of a complete group of panels respectively located at the panel removal station.

With respect to claim 7, Leuthold et al. disclose a transport device provided with: a plurality of carrier units 20, 40 that are spaced at intervals in a transport direction, each respective carrier unit having at least one carrier element 21, 41 projecting substantially perpendicular to the transport direction, such that: an associated group of panels 1,2 can be stacked on at least one carrier unit 20, 40, the group of panels 1, 2 can be transported as far as a panel removal station 30, and in each case an individual bodywork panel can be removed by a panel separation device 30 at the panel removal station, wherein the transport device is an inclined (C4/L43) transport device. The expression "an individual bodywork panel can be removed by a panel separation device at the panel removal station" is functional by nature such that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, Leuthold's apparatus is certainly capable of removing a panel by a panel separation device 31.

With respect to claim 8, Leuthold et al. disclose that a carrier element position can be adjusted in the transport direction. For example, Leuthold's carrier elements 21, 41 can be moved to any point along a transport position.

With respect to claim 9, Leuthold et al. disclose that a carrier element position can be adjusted transversely with respect to the transport direction, e.g. into and out of a transport direction. FIG. 5a-f.

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With respect to claim 10, Leuthold et al. disclose a number and/or design construction of carrier elements 21, 41 used in a carrier unit can be varied as a function of the geometric shape of a bodywork panel.

With respect to claim 12, Leuthold et al. disclose an inclined transport device with an adjustable transport direction.

With respect to claim 13, Leuthold et al. disclose as a panel removal pivoting gripper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leuthold et al. (US 5,803,446) in view of Lawson (US 3,162,292). Leuthold et al. does not explicitly disclose a transport device that moves carrier elements 21, 41 along a transport path but does disclose movement along a transport path. Leuthold et al. does not disclose a chain transport device. It is noted that the Examiner assumes the chain transport device moves the carrier elements but notes that no limitation appears in claim 11. Lawson discloses a chain transport device 30 which moves carrier elements 32 along a transport path which transfers and unscrambles boards from a larger stack of lumber items. C3. Thus, it would have been obvious to one of ordinary skill in the art to

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modify the apparatus of Leuthold et al. to include a chain transport device, as taught by Lawson, to separate lumber from a stack.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W. Adams whose telephone number is (571) 272-8101. The examiner can normally be reached on M-Th., 8:00-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford Lillis can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GWA


GENE O. CRAWFORD
SUPERVISORY PATENT EXAMINER